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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,175	06/25/2004	Hirokazu Matsumoto	61536 (46342)	3286
21874 7590 04/11/2007 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205			EXAMINER CHANDRA, GYAN	
			ART UNIT	PAPER NUMBER
			1646	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
31 DAYS		04/11/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/500,175

Applicant(s)

MATSUMOTO ET AL.

Examiner

Gyan Chandra

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 22 and 24-39 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Applicant's election with traverse of Groups 20-24 (discussed under VII) claims 22, 24 and 27, in the reply filed on 2/7/2007 is acknowledged.

Applicants have added new claims 28-39 reciting **at least 34 or more new polypeptide sequences** which require further Election/Restrictions.

The Examiner made a telephonic contact with attorney Kim on 3/7/2007 to explain that the applicant is required to elect a single group from the previous election/restriction requirement, and that Applicant's election of groups 20-24 which are drawn to a method of treating a mammal for body weight inhibition comprising administering a polypeptide as represented by the SEQ ID NO: 4, 16, 126, 138 or 144 is not in compliance with the previous Office Action requirement. Because Applicants have added new claims reciting many polypeptide sequences, the Examiner has determined that a new Restriction/Election would be required for a meaningful search of the instantly claimed inventions.

Claims 1-21 and 23 are withdrawn as being drawn to a non-elected invention (See Response and the Restriction Election mailed on 1/12/2007).

Claims 22 and 24-39 require **further restriction/election**.

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Claims 22 and 24-39 are drawn to the special technical feature of treating a mammal for body weight inhibition, body weight loss promotion, adipose gain inhibition or feeding inhibition comprising administering a polypeptide or an agonist, wherein said polypeptide or said agonist is represented by a number of polypeptide sequences listed in claims 21 and 24-39.

The above invention (claims 22 and 24-39) is drawn to a number of polypeptide sequences (e.g., SEQ ID NO: 6, 16, 17, 20, 21, 22, 23.....112, 113 and SEQ ID NO: 149). These polypeptide sequences are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 (page 3 of the previous Office Action).

Each of the claimed polypeptide sequences are composed of amino acid units and are structurally distinct molecules. Each sequence requires a unique separate search of the prior art. Searching for more than one claimed sequence would constitute an undue burden on the examiner and the USPTO's resource because of the non-coextensive nature of these searches. Therefore, Applicant must choose 1 sequence from the list of recited sequences against which the search should be performed.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their separate search requirements, restriction for examination purposes as indicated is proper.

**It is reminded to the applicant that the selection of an amino acid sequence is not a species election rather it is a restriction/election.**

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gyan Chandra whose telephone number is (571) 272-2922. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol can be reached on (571) 272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gyan Chandra, Ph.D.  
Art Unit 1646  
22 March 2007  
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